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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,807	07/17/2003	Arthur M.P. Doweyko	D0250 NP	1455

23914 7590 09/22/2006

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EXAMINER	
NASHED, NASHAAT T	

ART UNIT	PAPER NUMBER
1656	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/621,807	DOWEYKO ET AL.	
	Examiner	Art Unit	
	Nashaat T. Nashed, Ph. D.	1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-39* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claims 1-39 are pending and under consideration.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I-XXVIII. Claims 1-29, drawn to a multiple methods of at least 28 inventions in which a model of a receptor is constructed by homology modeling method and used to identify lignads for said receptor, classified in class 702, subclass 27. If one of these inventions is selected for prosecution, applicant should indicate the claims reading on the elected invention. This is not an election of species and only one protein will be examined.

XXIX. Claims 30-36, drawn to multiple inventions of generic compounds that bind to a generic NHR receptor, and its method of its use to modulate said receptor, classified in class 548, subclass 215+. If this invention is selected for prosecution, applicants should identify the NHR receptor, which the compound modulates. This is not an election of species and only one protein will be examined.

XXX. Claim 37, drawn to multiple inventions of generic mutants of NHR receptors, and its method of its use to modulate said receptor, classified in class 530, subclass 300+. If this invention is selected for prosecution, applicants should identify the NHR receptor, which is being mutated. This is not an election of species and only one protein will be examined.

XXXI. Claims 38 and 39, drawn to multiple generic methods for measuring the binding of a generic NHR receptor to a generic compound, and its method of its use to modulate said receptor, classified in class 436, subclass 86. If this invention is selected for prosecution, applicants should identify the NHR receptor, which is being mutated.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-XXVII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are directed to different *in silico* methods of identifying compounds that modulate the activities of different receptor having different biological functions, and would require different searches in the patent and non-patent literature. Applicants must elect one receptor for prosecution in this application.

Invention XXIX is directed to at least 28 unrelated inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are directed to different chemical

entities, which modulate different receptors having different structure and functions, and would require different searches in the patent and non-patent literature. Applicants must elect one receptor for prosecution in this application.

Invention XXX is directed to at least 28 unrelated inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are directed to mutants of different receptors having different structure and functions, and would require different searches in the patent and non-patent literature. Applicants must elect one receptor for prosecution in this application.

Invention XXXI is directed to at least 28 unrelated inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are directed to different methods to measure the binding between chemical entities and different receptors having different structure and functions, and would require different searches in the patent and non-patent literature. Applicants must elect one receptor for prosecution in this application.

Inventions I-XXVIII and XXX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together. Inventions I-XXVIII are directed to *in silico* methods of identifying compounds that bind to receptors wherein the compound of invention XXIX is not used, whereas invention XXIX is directed to chemical entity.

Inventions I-XXVIII and XXX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are not disclosed as capable of use together. Inventions I-XXVIII are directed to *in silico* methods of identifying compounds that bind to receptors, whereas invention XXX is directed to mutants of different receptors.

Inventions XXIX and XXX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are independent chemical entities and require different searches in the patent and non-patent literature.

Inventions XXIX and XXXI are directed to an unrelated product and process. Product and process inventions are unrelated if it can be shown that the product cannot

be used in, or made by, the process. See MPEP § 802.01 and § 806.06. In the instant case, the products of inventions XXIX can't be made by the process of inventions XXXI.

Inventions XXX and XXXI are directed to an unrelated product and process. Product and process inventions are unrelated if it can be shown that the product cannot be used in, or made by, the process. See MPEP § 802.01 and § 806.06. In the instant case, the products of inventions XXX can't be used, or made by the process of inventions XXXI.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

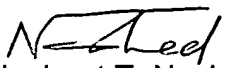
Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is 571-272-0934. The examiner can normally be reached on MTWTF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen M. Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nashaat T. Nashed, Ph. D.
Primary Examiner
Art Unit 1656